

35 USC §103 Rejections

The examiner has rejected claims 1-2, 5-9 and 12-20 as being unpatentable over Hiramoto (JP 8-102994) in view of Ono (JP 55-016546-A). In order to sustain a rejection under §103, the examiner must establish a *prima facie* case of obviousness by demonstrating that all of the claim limitations are taught or suggested in the prior art.¹ “[T]he Board ... must provide particular findings related thereto. Broad conclusory statements standing alone are not ‘evidence.’”² Additionally, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”³ Applicant respectfully avers in the paragraphs below that the examiner has made conclusory statements with little or no support, as well as pieced together elements of inventions that contain no suggestion to combine such elements.

Examiner asserts that all the elements of independent claims 1, 8 and 15 are revealed in the cited prior art. However, the air “inlet” of Hiramoto is not equivalent to the “fluid inlet” of the applicant’s speaker design. The examiner has not shown, and the applicant cannot find, any reference to a “fluid inlet” for liquids as disclosed in Applicant’s disclosure. “All words in a claim must be considered in judging the patentability of that claim against the prior art.”⁴ Thus, in the absence of any suggestion that the air inlets of the prior art be used for fluid, the claimed invention is not obvious.

¹ *In Re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974).

² *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000).

³ *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

⁴ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 CCPA 1970).

Further, if the intended function of the prior art is destroyed, then a reference may not be properly combined to establish a *prima facie* case of obviousness.⁵ Altering a speaker to permit the flow of fluid into it would most certainly damage the speaker's internal components, as well as have a profound effect on the transducer's ability to reproduce sound. It is for this reason that simply permitting a fluid connection to a speaker destroys critical properties of the speaker's function. Similarly, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.⁶ Air cooling in a speaker design as in the prior art is a different principle entirely from the self-contained liquid coolant properties proposed in the claimed invention. Similarly, the lack of liquid inlets in the prior art is vastly different from the design of the claimed invention. For these reasons, the prior art does not provide the obviousness basis that the examiner suggests.

Examiner's rejection of the above-referenced independent claims for obviousness is further incorrect because it does not consider all of the claim's limitations. According to *Miller*, when there is a new functional relationship in an invention, the claim must be read as a whole to determine its validity.⁷ The current application is not obvious because the additional limitations of the fluid inlets and outlets were not in the cited patents' claims. None of the prior art is directed toward, nor does it teach or suggest the solution taught herein. The claimed invention is a unique and novel functional relationship of the components presented, namely the fluid inlets and fluid outlets used to circulate coolant throughout the transducer.

⁵ *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Moreover, courts have consistently held that “obviousness cannot be established by combining the teachings of prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination.”⁸ There is no such suggestion that a t-yoke be designed with fluid inlets and fluid outlets for the purposes of maintaining temperatures within a loudspeaker in either reference cited by the examiner.

The examiner does not provide evidence that what he terms “obvious,” was even present in a prior art reference, namely the use of fluid inlets and fluid outlets to circulate fluid in order to cool a sound transducer. Nor has the examiner shown that the claimed invention would have been obvious at the time of conception of this application.⁹ Hindsight may not be used by the examiner,¹⁰ however it seems evident that the examiner has utilized hindsight to fill in the gaps between the prior art technology and the claimed invention, since there is no disclosure of a fluid inlet or fluid outlet.

Finally, the applicant has enjoyed great commercial success with this product, clearly demonstrating the lack of obviousness in the design presented. Further, applicant contends that if such a combination were obvious, it would have already been on the market or implemented. Applicant’s assertion that it knows of no other item ever being produced by another, coupled with the observation that while separately both speakers and radiation-based cooling have been around for decades but never combined, makes it readily apparent that such a combination is not, in fact, obvious. It is evident, then, that there is a long-felt need in the art for a solution such as

⁶ *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

⁷ *In re Miller*, 418 F.2d 1392, 64 U.S.P.Q. 46 (CCPA 1969).

⁸ *ACS Hospital Systems, Inc. v. Monteffiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

⁹ *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1986).

¹⁰ MPEP 2141

the one presented in this application. As the examiner is certainly aware, this objective evidence must be considered in making a determination of obviousness.¹¹

Dependent claims 2 and 5 through 7 have all been rejected under § 103 for the same reasons and in view of the same references as claim 1. These claims are dependent upon claim 1, and as such, contain all of the limitations of claim 1. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.¹² Therefore, to the extent that claim 1 is allowable, they are allowable, and the examiner is respectfully requested to withdraw the rejections entered against those claims as well.

Dependent claims 9 and 12 through 14 have all been rejected under § 103 for the same reasons and in view of the same references as claim 8. These claims are dependent upon claim 8, and as such contain all of the limitations of claim 8. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.¹³ Therefore, to the extent that claim 8 is allowable, they are allowable, and the examiner is respectfully requested to withdraw the rejections entered against those claims as well.

The rejection of Claims 16 through 20 by the examiner for being obvious in view of Hiramoto (JP 8-102994) in view of Ono (JP 55-016546-A) should also be withdrawn. Again, like the other dependent claims listed above, these must be read to include all the limitations of the claim, as well as any claims they depend from, yielding them non-obvious as their parent claims are.

¹¹ MPEP 2141.

CONCLUSION

All of the examiner's rejections deal with an alleged obviousness basis for rejection. It is important to note that "[m]ost if not all inventions arise from a combination of old elements. ... Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention."¹⁴ Furthermore, the prior art must teach the problem or its source in order to establish a *prima facie* case of obviousness.¹⁵ The problem solved here is a speaker with a fluid inlet and outlet for piping in fluid used to cool the speaker. The prior art does no combination of these things. Applicant respectfully requests that the examiner withdraw the rejections and permit this application to issue.

Based on the above amendments and remarks, applicant believes that all of the claims in the case are allowable and an early Notice of Allowance is respectfully requested. If the Examiner believes a telephone conference will expedite the disposition of this matter, he/she is respectfully invited to contact this attorney at the number shown below.

Respectfully submitted,

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¹² *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988).

¹³ *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988).

¹⁴ *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000).

¹⁵ *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 US 45 (1923).